

REMARKS

The Official Action mailed December 16, 2008, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to April 16, 2009. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes the *partial* consideration of the Information Disclosure Statement filed on March 24, 2006. Specifically, without further explanation, the Examiner lined through the citation of the following documents: JP 2000-023089, JP 2003-209789, JP 2003-110989, JP 2002-304806 and "International Search Report of December 24, 2003 for PCT/JP2003/012528." However, the Image File Wrapper appears to include a copy of each of the references noted above with a Mail Room Date of "03-24-2006." For at least the reasons stated below, the Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced references from the Information Disclosure Statement filed March 24, 2005.

The Applicant respectfully submits that the references noted above must be considered since they were cited on Form PTO-1449 in the IDS filed March 24, 2005, in full compliance with 37 CFR §§ 1.97 and 1.98. "An information disclosure statement filed in accordance with the provisions of 37 CFR § 1.97 and 37 CFR § 1.98 will be considered by the examiner assigned to the application" (MPEP § 609, emphasis added).

Also, the Applicant clearly explained that EP 0 969 463 is in the family of JP 2000-023089, that U.S. Patent Publication No. 2003/0152368 and EP 1 327 982 are in the family of JP 2003-209789, and that U.S. Patent Publication No. 2003/0059203 is in the family of JP 2003-110989. In the form PTO-1449, the Applicant noted these relationships with the labels "EP Equiv" or "U.S. Equiv" as appropriate. As such, JP

2000-023089, JP 2003-209789 and JP 2003-110989 should be considered for at least this reason.

Further, MPEP § 609.04(a), Section II, states that information which complies with 37 CFR § 1.97 and 1.98 but which is in a non-English language will be considered insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. As such, JP 2000-023089, JP 2003-209789, JP 2003-110989, JP 2002-304806 and "International Search Report of December 24, 2003 for PCT/JP2003/012528" should be considered for at least this reason.

Still further, although not in the English language, the last two pages of the International Search Report is provided in a standardized format. Specifically, the last two pages of the ISR includes English language information including the following: each of the JP references noted above are cited and categorized as "A" references, family data is provided for each reference, and a list of claims to which the reference is allegedly relevant is provided for each reference. As such, JP 2000-023089, JP 2003-209789, JP 2003-110989, JP 2002-304806 and "International Search Report of December 24, 2003 for PCT/JP2003/012528" should be considered for at least this reason.

Therefore, the Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the references noted above.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 21, 2006; and May 21, 2007.

Claims 1-4 and 17-25 were pending in the present application prior to the above amendment. Claims 1-3, 17-20, 22, 23 and 25 have been amended to better recite the features of the present invention, and claim 21 has been canceled without prejudice or disclaimer. Accordingly, claims 1-4, 17-20 and 22-25 are now pending in the present application, of which claims 1, 2 and 17 are independent. For the reasons set forth in

detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action objects to claims 1-4 and 17-25 for various informalities. Specifically, the Official Action states that “[c]laims 1-4 inconsistently recite claimed data as ‘content’, ‘content data’, and ‘broadcast content data’” (page 2, Paper No. 20081207). In response, the Applicant has amended claims 1-3 to consistently recite “broadcast content data.”

The Official Action states that “[c]laims 17-25 inconsistently recite claimed data as both ‘input content data’ and ‘content data’” (Id.). In response, the Applicant has amended claims 17-20 and 22 to consistently recite “input content data.”

The Official Action objects to claims 18, 21 and 22 under 35 U.S.C. § 1.75(c) “as being of improper dependent form for failing to further limit the subject matter of a previous claim” (page 3, Id.). Specifically, the Official Action asserts that “[t]hese claims essentially comprise descriptive recitations related to intended use and they fail to further limit the claimed apparatus” (Id.). In response, claim 18 has been amended to recite that “said control means operates to prohibit the input content data from being recorded in said recording medium,” and claim 22 has been amended to recite that “said control means operates to add information representing the insistence of the copyright as digital watermark information to the input content data.” The Applicant respectfully submit that amended claims 18 and 22 clearly further limit the subject matter of a previous claim and specifically further limit the claimed apparatus.

Claim 21 has been canceled without prejudice or disclaimer.

Accordingly, reconsideration and withdrawal of the objections are in order and respectfully requested.

The Official Action rejects claims 1-4 and 17-25 under 35 U.S.C. § 112, second paragraph, asserting that the claims are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention” (page 3, Id.). Specifically, the Official Action appears to be concerned with antecedent basis for

"the broadcast time" in claims 1 and 2, for "the content data permitted to record" and "the normal content data" in claim 2, for "the input content data" and "the time information" in claim 17, for "the identified time information" in claim 18, for "the information representing the insistence of the copyright" in claims 19, 20 and 22 (pages 3-4, Id.). It is noted that the Official Action probably refers to "the broadcasting time" in claims 1 and 2. In response, in claim 1, line 6, and in claim 2, line 7, "the broadcasting time" has been changed to "broadcasting time"; in claim 2, lines 10-11, "the content data permitted to record, or the normal content data" has been changed to "broadcast content data"; in claim 17, lines 1-2, "the input content data" has been changed to "input content data" and in line 8, "the time information" has been changed to "time information"; in claim 18, line 3, "the identified time information" has been changed to "identified time information"; and in claims 19 and 20, lines 3-4, and in claim 22, lines 2-3, "the information representing the insistence of the copyright" has been changed to "information representing the insistence of the copyright."

The Official Action is concerned with the clarity of the phrase "to judge whether or not the received content data is content data permitted to record, or the normal content data" in claim 2 (page 4, Id.). In response, claim 2, lines 9-11, have been amended to recite "to judge whether or not the received broadcast content data is broadcast content data which has been redistributed via a network."

The Official Action is concerned with the clarity of the phrase "or other equivalent information" in claims 19, 20 and 22 (page 5, Id.). In response, this phrase has been removed from claims 19, 20 and 22.

The Official Action is concerned with the clarity of the phrase "only when" in the context of claim 23 and "points out that the applicant appears for the claim to recite setting a time clock at the time of manufacture" (Id.). In response and consistent with the Examiner's suggestion, claim 23 has been amended to recite "wherein said clocking means is able to set the time clock at the time of manufacture of said data recording device."

The Official Action asserts that claim 25 is "generally narrative and indefinite" and that "the recitation 'the settable number of time clock' lacks any clear meaning" (Id.). In response, claim 25 has been amended to recite "wherein said clocking means imposes a restriction on the number of times by which the time clock can be set."

The Applicant respectfully submits that the above-referenced amended claims particularly point out and distinctly claim the subject matter which applicant regards as the invention and are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 1-4 and 17-25 as anticipated by U.S. Patent No. 6,310,956 to Morito. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).


Independent claims 1, 2 and 17 have been amended to include additional features relating to the digital watermark information, among other features. Specifically, independent claim 1 has been amended to recite digital watermark information adding means for adding two kinds of digital watermark information to broadcast content data, wherein said two kinds of digital watermark information are first digital watermark information having the type of data or medium of said broadcast content data to be set and second digital watermark information having time information representing broadcasting time of said broadcast content data to be set. Independent claim 2 has been amended to recite digital watermark information adding means for adding first digital watermark information to broadcast content data, said first digital watermark information having the type of data or medium of said broadcast content data to be set, wherein said digital watermark information adding means further operates to

add second digital watermark information having time information representing broadcasting time of said broadcast content data to be set. Independent claim 17 has been amended to recite input means for inputting content data to which two kinds of digital watermark information is added, said two kinds of digital watermark being first digital watermark information having the type of data or medium of said input content data to be set and second digital watermark information having time information representing recording or distributing time to be set. The Applicant respectfully submits that Morito does not teach the above-referenced features of the present invention, either explicitly or inherently.

Since Morito does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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